

REMARKS

The present amendment is in response to the Office Action dated March 5, 2008.

In the present amendment, claims 41-48 and 55-58 have been amended, with claims 55-58 renumbered correctly. Accordingly, claims 41 – 48 and 55 – 58 are pending in the present application with claims 41 and 46 being the independent claims.

Reconsideration and allowance of pending claims 41 – 48 and 55 – 58 in view of the amendments and the following remarks are respectfully requested.

A. Claim Objections

The examiner objects to the numbering of the claims as failing to meet the requirements of 37 CFR 1.126. Misnumbered claims 55-57 have been renumbered 55-58.

B. Rejection of Claims 41 and 46 under 35 USC § 112

Claims 41 and 46 are rejected under 35 USC 112 as failing to comply with the written description requirement. Paragraph one of 35 USC 112 states in full:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Nothing in this paragraph requires literal support of the claim language in the written description. To the contrary, the written description standard is that the written description must describe the invention “in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly

connected, to make and use the same.” Applicant asserts that use of the term “processor” in the claims and “controller” in the written description clearly meets the requirement under 35 USC 112 as any person skilled in the art of wireless communication devices would understand what those terms mean and how to make and use the claimed invention.

While Applicant does not agree that the rejection is correct on the merits, Applicant has amended the claims to change “processor” to “controller” in order to advance prosecution of this application. Applicant asserts that these amendments are not narrowing under the Festo line of cases.

C. Rejection of Claims under 35 U.S.C. § 103(a)

Claims 41-48 and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,208,872 issued to Schmidt (“Schmidt”) in view of US Patent No. 6,556,819 issued to Irvin (“Irvin”).

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a prima facie case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion

to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Combine

Combining the references will be moot in light of the amendment to the claim 41 clarifying that the process is initiated based on an received phone number in an attempt to make a phone call and not the actual placing of the phone call. For example the present claim 41 includes "receiving a phone number into the wireless communication device in an attempt to make a phone call," "utilizing a controller to determine the geographic characteristic of the received phone number," and "utilizing a controller to determine if at least a portion of geographic characteristic of the received phone number matches at least one geographic characteristic stored in the memory." The Office Action cites Schmidt as the only reference teaching these limitations. Thus if Schmidt fails to describe these limitations, combining Schmidt with the other references including Irvin and Agness will fail to cure the defect of Schmidt.

2. Reasonable Expectation of Success

Further, the modification of Schmidt with the teachings of Irvin and Agness fail to point to the reasonable expectation of success in light of the amended claims, which is the second requirement of the obviousness analysis. Thus the relevant limitations of claim 41, renders the combination moot.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. Applicant asserts that the combination of the references do not anticipate the amended claims.

For example, independent claim 41 has been amended to clarify that that the process is initiated based on a received phone number in an attempt to make a phone call and not the actual placing of the phone call. Thus independent claim 41 as amended, describes "receiving a phone number into the wireless communication device in an attempt to make a phone call," "utilizing a controller to determine the geographic characteristic of the received phone number," and "utilizing a controller to determine if at least a portion of geographic characteristic of the received phone number matches at least one geographic characteristic stored in the memory."

The examiner cites Schmidt (col. 7 lines 42-44; Fig. 5 ref. 82') for describing "receiving a phone number into the wireless communication device." Schmidt only describes that a user selects a group of phone numbers from memory. Even if the selecting of a group of phone numbers described in Schmidt is construed as receiving of a phone number, the process that is initiated as a result of the received phone number is independent of the received phone number. For example in response to the selection of the group phone numbers in Schmidt, the determinator checks to see if the mobile station is roaming. Whether or not the mobile station is roaming depends on the location of the mobile station and not on the selected group numbers. On the other hand claim 41 describes "utilizing a controller to determine the geographic characteristic of the received phone number," "utilizing a controller to determine if at least a portion of geographic characteristic of the received phone number matches at least one geographic characteristic stored in the memory." Any process related to the selected group numbers or any number in Schmidt only takes effect after a phone call is placed or received relating to the selected group numbers or if the selected group numbers are

transmitted. In fact Schmidt specifically states in col. 7 lines 35 to 40, that "the present invention is concerned with the transmission and receipt of calls when the mobile station [is]...roaming."

The examiner cites Schmidt (col. 6 lines 15-16 and 27-38) for describing "utilizing the controller to determine if at least a portion of the received phone number matches at least one geographic characteristic stored in memory. With regards to this limitation claim 41 has been amended to read "utilizing a controller to determine the geographic characteristic of the received phone number," and "utilizing a controller to determine if at least a portion of geographic characteristic of the received phone number matches at least one geographic characteristic stored in the memory." Applicant asserts that Schmidt fails to disclose this limitation. For example col. 6 lines 15-16 and 27-38 of Schmidt simply states that the call initiator for making calls by the user, a transceiver for transmitting and receiving communication, the memory and other identified elements are controlled by the processor without giving any specifics to the actual processes that are controlled by the processor or in what sequence the processor controls the identified elements. Here Schmidt at least fails to describe processes that are initiated by the received phone number. Particularly Schmidt fails to describe "utilizing a controller to determine the geographic characteristic of the received phone number," and "utilizing a controller to determine if at least a portion of geographic characteristic of the received phone number matches at least one geographic characteristic stored in the memory."

Schmidt, Irvin, and Agness do not teach, suggest, or describe these limitations. Irvin (and alternatively Agness) is cited for teaching determining a physical location of

the device in accordance with the global position system and therefore does not cure the defects of Schmidt.

Accordingly, because the combination of references does not include all of the limitations of independent claims 41 and 46 (has similar limitations as claim 41), Applicant requests that the rejections be withdrawn and a notice of allowance be issued for claims 41 – 48 and 55 – 57.

4. Effect of KSR

After the recent Supreme Court decision in the KSR case, although it is clear that the above analysis using the Federal Circuit's teaching-suggestion-motivation test is not the only way to approach the obviousness inquiry, it remains a useful tool in the obviousness inquiry. However, even if an alternative tool is employed as part of the obviousness inquiry, it is clear from KSR that any combination of references in an obviousness rejection must provide reasonable inferences that are based on substantial evidence in the record. Here, no such substantial evidence has been identified and therefore even after KSR, Applicant asserts that the pending claims are not obvious in view of the prior art of record.

D. Conclusion

For all the foregoing reasons, allowance of claims 41 – 48 and 55 – 58 pending in the present application is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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